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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,166	12/13/2000	Hiroji Fukui	M&M-033-USA-	2519

7590 05/20/2003  
Townsend & Banta  
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SUITE 900, SOUTH BUILDING  
Washington, DC 20004

EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/20/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/719,166

Applicant(s)

FUKUI, HIROJI

Examiner

Sanza L McClendon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 5-7 is/are allowed.
- 6) ☒ Claim(s) 4 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. In response to the Amendment received on March 11, 2003, the examiner has carefully considered the amendments. The request filed on October 21, 2002 for a Request for Continued Examination (RCE) under 35 CFR 1.114 based on parent Application No. 09/719,916 is acceptable and a RCE has been established. An action on the RCE can be found in paper number 12. Additionally the amendment to the claims under 37 CFR 1.116 filed September 03, 2002 was entered and can be found in paper number 9. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claims 1 and 7 has been overcome by the amendment and has hereby been withdrawn for consideration.

2. The Declaration under 37 CFR 1.132 filed March 11, 2003 is sufficient to overcome the rejection of claims 1-3 and 5-7 based upon Lamanna et al (US 5,554,664) and Mahoney et al (5,672,637). Said declaration clarifies the issue that the "low thermal catalytic activity in the approximate range of 20 to 80 °C" for the onium salts are well-known for onium compounds in the art and means that said onium salts cannot have or has substantially no catalytic activity in the range of 20 to 80 °C.

### *Response to Arguments*

3. Applicant's arguments, see paper number 1323, filed March 13, 2003, with respect to claims 1-8 have been fully considered and are persuasive. The rejection of claims 4 and 8 under 35 USC 102(b) as being anticipated by Lamanna et al (5,554,664) has been withdrawn. The rejection of claims 1-3 and 6-7 under 35 USC 102(b), or in the alternative, under USC 103(a) as unpatentable over Lamanna et al (5,554,664) has been withdrawn. The rejection of claim 5 as being obvious over Lamanna et al under 35 USC 103(a) has been withdrawn. The rejection of claims 1-3 and 6-7 as being obvious over Mahoney et al in view of Lamanna et al under 35 USC 103(a) has been withdrawn. The rejection of claims 4 and 8 under 35 USC 102(b) as being anticipated by Lamanna et al (5,554,664) still stands and can be found in paper number 12. Because claim 4 does not positively recite the limitation "low thermal catalytic activity in the approximate range of 20 to 80 °C", it is still anticipated by the prior art, specifically Lamanna et al (5,554,664) as described in paper number 12.

### *Allowable Subject Matter*

3. Claims 1-3 and 5-7 are allowed.

4. The following is an examiner's statement of reasons for allowance: Applicant's declaration filed March 13, 2003 clarifies that the "low thermal catalytic activity in the approximate range of 20 to 80 °C" for the onium salts are well-known for onium compounds in the art and means that said onium salts cannot have or has substantially no catalytic activity in the range of 20 to 80 °C; and therefore the claim limitation helps overcome the prior art. The prior art fails to teach a cationic photocatalyst composition comprising a photosensitive onium salt having low thermal catalytic activities in the approximate range of 20 to 80

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OC, and a compound either represent by formula (1) (compound B) or having as a substituting group, a structure of the formula (1) with the corresponding definitions found in claim 1. Nor does the prior art teach the above cationic photocatalyst composition wherein said photosensitive onium salt is selected from the group consisting of aromatic diazonium salts, aromatic iodonium salts and aromatic sulfonium salts.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

**Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (703) 305-0505. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

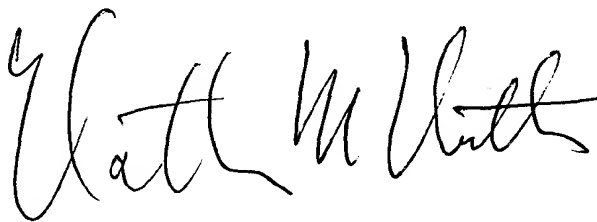
Sanza L McClendon

Examiner

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SMc

May 19, 2003



NATHAN M. NUTTER  
PRIMARY EXAMINER  
GROUP 1711